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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/611,279 01/17/01 MAZUR

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PM82/1107

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EXAMINER

SHAPIRO, J

JOHN C GATZ  
JENKENS & GILCHRIST  
SUITE 3200  
1445 ROSS AVENUE  
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ART UNIT

PAPER NUMBER

3651

10

DATE MAILED: 11/07/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/611,279

Applicant(s)

MAZUR ET AL.

Examiner

Jeffrey A. Shapiro

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 and 164-337 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 164-337 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8 & 9.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

**DETAILED ACTION**

***Priority***

1. This application discloses and claims only subject matter disclosed in prior Application No. 08/864,423, filed 5/28/97, and names an inventor or inventors named in the prior application. Accordingly, it is acknowledged that this application constitutes a continuation.

***Specification***

2. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

4. Claims 1 and 164-337 are rejected under 35 U.S.C. 102(a) as being anticipated by Ishida et al (US 5,419,423).

Ishida et al discloses the method of evaluating a stack of bills as follows.

As described in Claim 164;

1. transporting the bills, one at a time, from the input receptacle to one of two or more output receptacles of the currency evaluation device;

2. counting and determining the denomination of the bills utilizing a detector positioned along a transport path between the input receptacle and the output receptacles;
3. determining whether the bills meet or fail to meet a non-piece count related criterion;
4. halting the transporting when a bill meets or fails to meet the criterion;
5. the halting is performed such that the flagged bill is positioned as the last bill in one of the output receptacles;

Note that whatever the rate of bills counted per minute, the apparatus of Ishida et al nonetheless operates such that the method of Applicants' is necessarily performed.

5. Claims 1 and 164-337 are rejected under 35 U.S.C. 102(a) as being anticipated by Takesako.

Takesako discloses the method of evaluating a stack of bills as follows.

As described in Claim 164;

1. transporting the bills, one at a time, from the input receptacle to one of two or more output receptacles of the currency evaluation device;
2. counting and determining the denomination of the bills utilizing a detector positioned along a transport path between the input receptacle and the output receptacles;
3. determining whether the bills meet or fail to meet a non-piece count related criterion;

4. halting the transporting when a bill meets or fails to meet the criterion;
5. the halting is performed such that the flagged bill is positioned as the last bill in one of the output receptacles;

Note that whatever the rate of bills counted per minute, the apparatus of Ishida et al nonetheless operates such that the method of Applicants' is necessarily performed.

6. Claims 1 and 164-337 are rejected under 35 U.S.C. 102(a) as being anticipated by Takizawa et al.

Takizawa et al discloses the method of evaluating a stack of bills as follows.

As described in Claim 164;

1. transporting the bills, one at a time, from the input receptacle to one of two or more output receptacles of the currency evaluation device;
2. counting and determining the denomination of the bills utilizing a detector positioned along a transport path between the input receptacle and the output receptacles;
3. determining whether the bills meet or fail to meet a non-piece count related criterion;
4. halting the transporting when a bill meets or fails to meet the criterion;
5. the halting is performed such that the flagged bill is positioned as the last bill in one of the output receptacles;

Note that whatever the rate of bills counted per minute, the apparatus of Ishida et al nonetheless operates such that the method of Applicants' is necessarily performed.

7. Claims 1 and 164-337 are rejected under 35 U.S.C. 102(a) as being anticipated by Yoshihara.

Yoshihara discloses the method of evaluating a stack of bills as follows.

As described in Claim 164;

1. transporting the bills, one at a time, from the input receptacle to one of two or more output receptacles of the currency evaluation device;
2. counting and determining the denomination of the bills utilizing a detector positioned along a transport path between the input receptacle and the output receptacles;
3. determining whether the bills meet or fail to meet a non-piece count related criterion;
4. halting the transporting when a bill meets or fails to meet the criterion;
5. the halting is performed such that the flagged bill is positioned as the last bill in one of the output receptacles;

Note that whatever the rate of bills counted per minute, the apparatus of Ishida et al nonetheless operates such that the method of Applicants' is necessarily performed.

8. Claims 1 and 164-337 are rejected under 35 U.S.C. 102(a) as being anticipated by McInerny.

McInerny discloses the method of evaluating a stack of bills as follows.

As described in Claim 164;

1. transporting the bills, one at a time, from the input receptacle to one of two or more output receptacles of the currency evaluation device;
2. counting and determining the denomination of the bills utilizing a detector positioned along a transport path between the input receptacle and the output receptacles;
3. determining whether the bills meet or fail to meet a non-piece count related criterion;
4. halting the transporting when a bill meets or fails to meet the criterion;
5. the halting is performed such that the flagged bill is positioned as the last bill in one of the output receptacles;

Note that whatever the rate of bills counted per minute, the apparatus of Ishida et al nonetheless operates such that the method of Applicants' is necessarily performed.

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1 and 164-337 are rejected under 35 U.S.C. 102(b) as being anticipated by Walkley et al.

Walkley et al discloses the method of evaluating a stack of bills as follows.

As described in Claim 164;

1. transporting the bills, one at a time, from the input receptacle to one of two or more output receptacles of the currency evaluation device;
2. counting and determining the denomination of the bills utilizing a detector positioned along a transport path between the input receptacle and the output receptacles;
3. determining whether the bills meet or fail to meet a non-piece count related criterion;
4. halting the transporting when a bill meets or fails to meet the criterion;
5. the halting is performed such that the flagged bill is positioned as the last bill in one of the output receptacles;

Note that whatever the rate of bills counted per minute, the apparatus of Ishida et al nonetheless operates such that the method of Applicants' is necessarily performed.

### ***Double Patenting***

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).



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12. Claims 1 and 164-337 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the Claims of each of the following U. S. Patent No.'s individually. They are;

5,295,196; 5,430,664; 5,467,405; 5,790,697; 5,806,650; 5,815,592; 5,867,589; 5,870,487; 5,875,259; 5,905,810; 5,992,601; 6,012,565; 6,073,744; 6,220,419 B1; 6,237,739 B1; 6,241,069 B1; 6,278,795 B1; 6,311,819 B1(currently unavailable).

Although the conflicting claims are not identical, they are not patentably distinct from each other because they either claim an apparatus that can perform the method, a method, or a combination of method and apparatus directed toward the following.

a method and apparatus for discriminating and counting currency bills including receiving a stack of bills, transporting the bills, counting and determining the denominations of the bills utilizing a detector, determining whether the bills fail or meet certain criteria, halting the transporting when a failing bill is identified, and placing the failed bill as the last bill in one of the output receptacles.

13. Claims 1 and 164-337 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1 and 164-327 of both copending Application No.'s 09/541,170 and 09/542,487; Claims 157, 158 and 164-190 of copending Application No. 09/635,967; Claims 164-337 of copending Application No. 09/607,019; Claims 1-145 of copending Application No. 09/684,103, claims of Application No. 09/126,580. Although the conflicting claims are

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not identical, they are not patentably distinct from each other because they are directed toward the following.

a method and apparatus for discriminating and counting currency bills including receiving a stack of bills, transporting the bills, counting and determining the denominations of the bills utilizing a detector, determining whether the bills fail or meet certain criteria, halting the transporting when a failing bill is identified, and placing the failed bill as the last bill in one of the output receptacles.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The Examiner notes that Application 09/864,423, which is commonly owned by the Applicants is currently unavailable to the Examiner for review of double patenting issues.

### ***Conclusion***

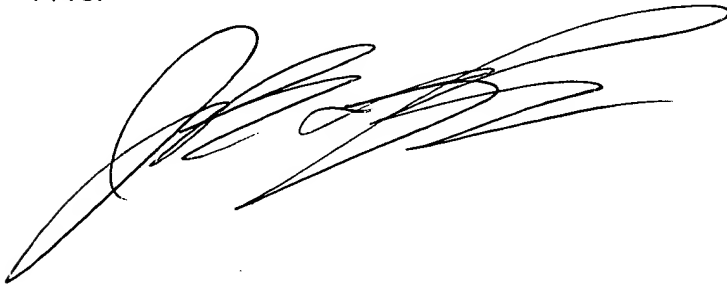
14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Finkel et al, Iizuka et al, De Man, Akioka, Collins, Cargill et al, Zwahlen et al, Hopwood et al, Isobe, Gardellini, Kobayashi et al, Mikkelsen et al, Winkler, O'Maley and Hatamachi et al are cited as examples of bill processing units with discriminators.

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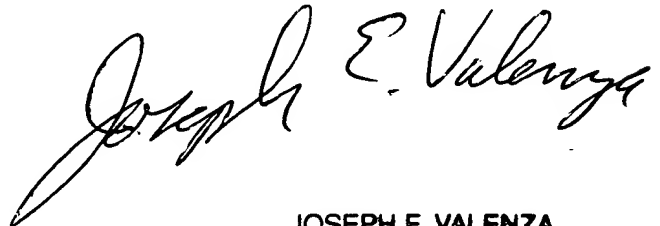
15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey A. Shapiro whose telephone number is (703)308-3423. The examiner can normally be reached on 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher P. Ellis can be reached on (703)308-2560. The fax phone numbers for the organization where this application or proceeding is assigned are (703)308-0552 for regular communications and (703)308-0552 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1113.



Jeffrey A. Shapiro  
Patent Examiner,  
Art Unit 3651



JOSEPH E. VALENZA  
PRIMARY EXAMINER

November 4, 2001